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(YOR.427)

### **REMARKS**

Claims 1, 2, 5, 6, 11, 12, 14, 15, 17, 19-23, 25, and 26 are all of the claims presently pending in the application. Applicants have canceled claims 8, 9, 16, and 18 without prejudice or disclaimer. Applicants have amended claims 1 and 20 to define the claimed invention more particularly.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 2, 5, 6, 8, 9, 11, 12, 14-23, 25, and 26 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 8, 16, 18, 20, and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 2, 5, 6, 8, 9, 11, 14, 15, 17-19, 22, 23, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kamata, et al. (U.S. Publication No. 2002/0142192; hereinafter “Kamata”) in view of Kitada, et al. (U.S. Patent No. 4,411,757; hereinafter “Kitada”). Claims 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kamata in view of Kitada and Ning, et al. (U.S. Publication No. 2002/0098676; hereinafter “Ning”). Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kamata in view of Kitada and Baglin, et al. (U.S. Patent No. 6,331,364; hereinafter “Baglin”). Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kamata in view of Kitada and Chen, et al. (U.S. Patent No. 6,165,803; hereinafter “Chen”).

Applicants respectfully traverse these rejections in the following discussion.

## **I. THE CLAIMED INVENTION**

The claimed invention of exemplary claim 1 is directed to a method of patterning a magnetic thin film. The method includes transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical transformation. The chemical transformation uses a reactive plasma including a combination of a fluorine-based gas and a bromide-containing gas. The portion of the magnetic thin film includes NiFe and the transforming includes transforming the NiFe to a fluorine-containing film, and wherein the fluorine-containing film is electrically insulating. (See Application at page 7, lines 11-23).

## **II. WRITTEN DESCRIPTION REQUIREMENT**

The Examiner has rejected claims 1, 2, 5, 6, 8, 9, 11, 12, 14-23, 25, and 26 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner alleges that originally filed specification does not disclose that the portion of the magnetic film includes  $\text{Ni}_{0.8}\text{Fe}_{0.2}$ . The Examiner, however, is clearly incorrect.

That is,  $\text{Ni}_{0.8}\text{Fe}_{0.2}$  is the chemical formula for Permalloy, which is disclosed throughout the specification. Applicants, however, merely in an effort to speed prosecution, have removed the chemical formula  $\text{Ni}_{0.8}\text{Fe}_{0.2}$  from the claims.

Accordingly, the amendments to the claims render the Examiner's rejection moot.

Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

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### **III. THE INDEFINITE REJECTION**

The Examiner has rejected claims 8, 16, 18, 20, and 21 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

Applicants, merely in an effort to speed prosecution and in accordance with the amendments to claim 1, have canceled claims 8, 16, and 18. Thus, the Examiner's rejection with respect to claims 8, 16, and 18 is rendered moot.

Furthermore, Applicants have amended claim 20 to depend from claim 2 to provide antecedent basis for "said mask".

Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

### **IV. THE PRIOR ART REFERENCES**

#### **A. The Alleged Combination of Kamata and Kitada**

The Examiner alleges that one of ordinary skill in the art would have combined Kamata with Kitada to teach the claimed invention of claims 1, 2, 5, 6, 8, 9, 11, 14, 15, 17-19, 22, 23, 25, and 26. Applicants submit, however, that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, the alleged combination of references does not teach or suggest, "*transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical transformation, said chemical transformation comprises using a reactive plasma comprising a combination of a fluorine-based gas and a bromide-containing gas*" (emphasis added by Applicants), as recited in exemplary claim 1.

The Examiner alleges that Kamata discloses transforming a portion of the magnetic film to be non-magnetic using a chemical formula. Furthermore, the Examiner alleges that Kamata discloses that the transforming uses a fluorine-based reactive plasma.

Kamata, however, does not teach or suggest that the reactive plasma includes a combination of a fluorine-based gas and a bromide-containing gas.

Furthermore, Kitada fails to make up the deficiencies of Kamata. Indeed, the Examiner merely relies on Kitada as teaching the use of a Ni-Fe alloy.

Therefore, Applicants submit that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

#### **B. The Secondary References**

The Examiner alleges that one of ordinary skill in the art would have combined Ning with Kamata and Kitada to teach the claimed invention of claim 12. Furthermore, the Examiner alleges that one of ordinary skill in the art would have combined Baglin with Kamata and Kitada to teach the claimed invention of claim 16. Furthermore, the Examiner alleges that one of ordinary skill in the art would have combined Chen with Kamata and Kitada to teach the claimed invention of claims 20 and 21. Applicants submit, however, that, even if combined, the alleged combinations of references would not teach or suggest each and every feature of the claimed invention.

That is, Applicants submit that claims 12, 16, 20, and 21 are allowable at least based on similar reasons to those set forth above in section A with respect to claims 1, 2, 5, 6, 8, 9,

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11, 14, 15, 17-19, 22, 23, 25, and 26.

Therefore, Applicants submit that, even if combined, the alleged combinations of references would not teach or suggest each and every feature of the claimed invention.

Therefore, Applicants respectfully request the Examiner to reconsider and withdraw these rejections.

## **V. FORMAL MATTERS AND CONCLUSION**

Applicants have canceled claims 8 and 9, thus rendering the Examiner's objection to the claims moot.

In view of the foregoing, Applicants submit that claims 1, 2, 5, 6, 11, 12, 14, 15, 17, 19-23, 25, and 26, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Applicants respectfully request the Examiner to pass the above application to issue at the earliest possible time.

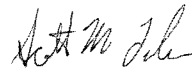
Should the Examiner find the application to be other than in condition for allowance, Applicants requests the Examiner to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The undersigned authorizes the Commissioner to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: October 23, 2008



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